

Serial Application No. 10/688,423

RECEIVED  
CENTRAL FAX CENTER

NOV 22 2006

REMARKS

1. Applicant thanks the Examiner for his remarks and suggestions which have greatly assisted Applicant in responding.

5

2. **35 U.S.C. § 112**

Claim 26 stands rejected under 35 U.S.C. § 112, 1<sup>st</sup> paragraph as failing to comply with the written description requirement. Claim 26 is amended to describe "wherein said number of songs that are cached and size of said  
10 different buffer are specified by a user." Support for amended claim 26 is found in paragraph 0030 of U.S. published application no. 2004/0138948: "The number of clips to cache in advance and the size of the pre-buffer cache can be specified." The present rejection is therefore deemed overcome.

Claim 29 stands rejected under 35 U.S.C. § 112, 1<sup>st</sup> paragraph as failing  
15 to comply with the written description requirement. Applicant respectfully disagrees. Support for claim 29 is found at paragraph 0066 of U.S. published application no. 2004/0138948: "If the application is configured to keep the skipped pre-buffered data for a short period of time, for example for 10 seconds, the user could. . . come back to any of the songs before it is deleted from the  
20 buffer." The present rejection is therefore deemed improper.

Claim 30 stands rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Claim 30 is cancelled from the Application, rendering the present rejection moot.

25

2. **35 U.S.C. § 103**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references

Serial Application No. 10/688,423

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

5 MPEP § 2143.

Claims 1, 6 and 16 stand rejected as being unpatentable over U.S. Patent No. 6,502,194 ("Berman") in view of U.S. published application no. 2001/0030660 ("Zainoulline") and further in view of U.S. published application no. 10 2002/0059237 ("Kumagai"). Applicant respectfully disagrees. The Examiner relies on Berman, col. 12, lines 10-16 as teaching "said downloaded small portions being pre-cached in a . . . buffer which is an area in said second memory[.]" Thus, as described in the independent claims, the small portions are downloaded into a common buffer.

15 In stark contrast, as shown in Figure 11 and described in the cited teaching, Berman provides multiple buffers, wherein a single buffer is dedicated to each song. It is applicant's position that the claim language in its present state is distinct from Berman because the ordinarily-skilled practitioner, reading the language of the independent claims, would readily understand that multiple small 20 portions are downloaded to a single buffer. Therefore, throughout prosecution of the application, the Examiner has improperly maintained that the claim language reads on Berman's multiple buffers.

In spite of the foregoing, in the interest of describing the invention with greater clarity, Applicant amends each of the independent claims to describe that 25 the small portions are downloaded to a "common buffer." The present amendment is already implicitly described in the claims. Additional support for the amendment is found, for example, in the specification of U.S. published application no. 2004/0138948 at, for example, ¶ 0070: "pre-cache the downloaded small portions in a buffer which is an area of the user's computer 30 memory." The specification is replete with additional references to a buffer and the small portions in the buffer.

Serial Application No. 10/688,423

Zainouline adds nothing to Berman. As the Examiner indicates, while Zainouline describes a staging memory, there is no teaching or suggestion in Zainouline of a common buffer.

Kumagai adds nothing to the combination of Berman and Zainouline.  
5 Kumagai does mention that storage area 208 in the distribution terminal may be used as a transfer buffer (§ 0274). However, there is no teaching or suggestion in Kumagai of pre-caching small portions to a common buffer.

There is, therefore, no teaching or suggestion in the combination of "said downloaded small portions being pre-cached in a common buffer which is an  
10 area in said second memory."

Therefore, the combination does not teach or suggest all elements of the independent claims. As such, the present rejection is deemed overcome. Even if the claims had not been amended, the present rejection would have been improper because, as Applicant has persuasively shown, the subject matter of  
15 the independent claims was not taught or suggested by the combination.

The following remarks apply only to claim 1 (and dependent claims 7, 17, 10 and 20):

The Examiner relies on Berman, col. 12, lines 25-20 as teaching or suggesting "wherein as soon as said target song starts to play, deleting any pre-cached song prior to said target song in said pre-determined sequence."  
20 Applicant respectfully disagrees.

The Examiner is respectfully reminded that Berman provides multiple buffers, and that each buffer contains one song (col. 11, line 4) of a sequence. As described at col. 11, line 66 to col. 12, line 16, in a sequence of songs  
25 "Song1, song2 and song 3," song1 is placed into a first buffer 1102, song2 is placed into a second buffer 1104 and song3 is placed into a third buffer 1106 (Figure 11). Thus, if the target song were song3, as song3 is downloaded, the data for song3 that have already been processed and played are overwritten.

Serial Application No. 10/688,423

However, overwriting the data in buffer 1106 would have no effect at all on the buffers holding the songs preceding the target song in the sequence, song1 and song2, which were downloaded to buffers 1102 and 1104, respectively.

5 In fact, Berman explicitly says that a skipped song "remains in the playback unit memory so the user can return to the skipped song and listen to it." (col. 12, lines 50-52, emphasis added) Further Berman adds "overwriting will not begin until listening to that song has begun." (col. 12, line 55-57, emphasis added).

10 In spite of the foregoing, in the interest of describing the invention with greater clarity, Applicant amends the claims in question to describe "deleting any pre-cached song preceding said target song in said pre-determined sequence." The amended subject matter is implicitly described in the claims. Additional support for the amendment is found in the specification at Figure 2C and the accompanying description and further at Figure 3D step 338: "Skip to another  
15 song?" If yes, program flow goes to step 330A of Fig. 3C: "Has the target song been pre-cached?" If yes, program flow goes to step 330 in Figure 3D: "Play the small portion of the target song; Start to download the rest of the target song. Delete any pre-cached song prior to the target song."

20 Applicant notes that Berman also describes that, if the user selects more songs than can fit into memory, a newer song on the play list will begin overwriting the oldest song in memory. (col. 12, lines 56-63) However, the triggering event for this is that the last segment of the last buffer is full, not that the user skipped a song in the play list. And the only song that is overwritten is the oldest song in memory, not any pre-cached song preceding said target song  
25 in said pre-determined sequence.

Because Berman teaches that each of the songs of a sequence are stored in separate buffers, and that, as a song is downloaded into a buffer, data from that song only, is overwritten as it is processed and played, there is no teaching in Berman of "deleting any pre-cached song preceding said target song in said

Serial Application No. 10/688,423

pre-determined sequence." Neither Zainoulline nor Kumagai add anything to Berman.

5 The present rejection would have also been improper because Berman expressly teaches keeping a skipped song in memory so that the user can return to the skipped song and listen to it. Thus, there would have been no motivation to modify Berman to make the claimed invention because the modification would have rendered Berman unsuitable for its original purpose.

10 Claim 31: Applicant notes that the Examiner cites no authority for the present rejection, although it is apparently a '103 rejection. Claim 31 has been amended to describe that the small portions of the video clips are pre-cached in a common buffer. As described above, there is no teaching or suggestion in the combination of a common buffer. Accordingly, the present rejection is deemed overcome.

15 In view of the foregoing, the independent claims are deemed allowable. In view of their dependence from allowable parent claims, the dependent claims are deemed allowable without any separate consideration of their merits. Nevertheless, Applicant provides the following comments on the dependent claims:

20 Claims 8 and 18: The present claims are amended to correct a typographical error. The term "executively" is amended to "consecutively." Support for the amendment is found in claims 1, 6 and 16.

Claims 11 and 21: The present claims are amended similarly to claims 8 and 18.

Serial Application No. 10/688,423

RECEIVED  
CENTRAL FAX CENTER

NOV 22 2006

## CONCLUSION

5 In view of the foregoing, the claims are deemed to be in allowable condition. Applicant therefore earnestly requests reconsideration and prompt allowance of the claims. Should the Examiner have any questions regarding the Application, he is urged to contact Applicant's attorney at 650-474-8400.

Respectfully submitted,

10

*Julia A. Thomas*

Julia A. Thomas

Reg. No.: 52,283

15